

In re Patent Application

Serial No. 09 / 219 , 478

Filed: December 22, 1998

Examiner: Michael Pender

Protest under 37 CFR 1.291

Exhibit G

Letter from Michael Smialek to L. Keith Stephens, and others dated
2/9/2000.

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Mike Smialek
1548 Meadow Lane
Glenview, IL 60201
MikeSmialek@Hotmail.com
847-869-1595
February 09, 2000

L. Keith Stephens
Hickman, Stephens, Coleman & Hughes
200 Page Mill Rd.
Palo Alto, CA 94306

Dear Mr. Stephens,

I was an employee of Andersen Consulting from August, 1992– August, 1998 and was deeply involved in several of their Business Simulation client engagements. I have personal first hand knowledge that every aspect of the subject matter described in the claims of US Patent No.'s 5987443, 6016486, 6003021, 6018730, 6018731, 6018732, 6023691, and 6023692 as well as what is described in the specifications of said patents had been reduced to practice, was ready for patenting, and was used commercially on for-fee client engagements in the context of Goal Based Learning as early as 1993, well before the critical date of December 22, 1997.

This subject matter was used in many demonstrations and offers for sale. Several of said offers for sale subsequently became for-fee client projects. Completed business simulation applications as well as the tools, components, architectures, and methods used to develop them were demonstrated during sales activities to prospective clients not bound by confidentiality agreements well before the critical date. The tools, components, architectures, and methods were used commercially on for-fee client engagements well before the critical date.

The descriptions of the patents disclose several components:

1. The rules based expert system (Tutor),
2. The spreadsheet component (Simulation Engine),
3. The system dynamics component (SysDyn Engine),
4. The ICA Meeting component,
5. The HTML help component,
6. The InBox component

They also disclose several workbenches:

1. ICAUtils Workbench, which houses the other workbenches,
2. ETSICA (Tutor) Workbench, which edits data used by the Tutor,
3. Regression Test workbench, which replays user acceptance tests,
4. Simulation Workbench, which simulates a user interface to test Tutor feedback,
5. Simulation Object Editor, which associates spreadsheets to Tutor data,
6. SysDyn Workbench, which simulates a user interface to test Tutor feedback,
7. SysDyn Object Editor, which associates Powersim data to Tutor data,
8. ICAMeeting Workbench, which simulates a user interface to test Tutor feedback,
9. ICAMeeting Object Editor, which associates ICAMeeting data to Tutor data,
10. Doc Maker, for saving Tutor data from a database into serialized files

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11. Object Viewer, for statically viewing Tutor data.

All of the above subject matter was reduced to practice, ready for patenting, and in commercial use on the following for-fee client engagements:

1. Financial Foundations Course, General Electric Corp, 1995-1996
2. Financial Accounting for Operations, General Electric Corp, 1996
3. Business Decision Making, Pratt & Whitney, 1996-1997
4. Strategic Business Partnering Course, Lucent Technologies, 1997-1998

All of Andersen Consulting's ideas and theories about Goal Based Learning and Business Simulation had already been in commercial use on the following projects:

1. Business Practices Course, (used internally, demonstrated externally), approximately 1993-1994
2. Credit Operations and Risk Evaluation, GE Capital, 1993-1995
3. enCORE, GE Capital, 1995-1997

I would urge you to ask Andersen Consulting employees, and specifically William Stoddard, about these client engagements. I'm sure you will find that all of the subject matter in question is ineligible for patent.

In addition to the uncorrectable defects related to the statutory bar, the patents suffer from misjoinder and nonjoinder of inventorship. I was in fact the primary inventor of '443, '021, '732, and '692. I was a contributing inventor of '486, '730, '731, and 691. Several of the patents list inventors that made no contribution and omit other inventors that made contributions.

Based on comments made by William Stoddard of Andersen Consulting, I believe there are additional patents that have been applied for but not yet issued. It is very likely that they suffer from the same defects. As I understand it, you have a duty to disclose this information to the Patent and Trademark Office with respect to the issued and pending patents.

Please contact me within ten days to discuss these issues. I would be happy to answer any questions you may have. If necessary I can furnish you with names of current and former AC employees and client employees that can verify the above information.

Sincerely,

Mike Smialek

CC: Vicki St. John
CC: Kevin Rhodes
CC: Robert Beiser

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